

U.S. Serial No. 10/820,373

Docket No. 4819-4701

REMARKS

Claims 1 and 3-7 are pending. Applicants thank the Examiner for the indication that claim 7 is allowed.

Claim 1 is amended to incorporate claim 2 and an element from claim 7. Support for the amendment can be found in previously presented claims 2 and 7. No new matter is entered. No new issues are raised by the amendment because claims 2 and 7 were pending before the date of the final rejection. Applicants respectfully request entry of the amendment after final rejection.

Drawing

The requirement for a drawing from the Office Action of September 29, 2005 was traversed in Applicants' response of February 24, 2006. The requirement was not re-stated in the Office Action of March 6, 2006. Applicants request confirmation that the requirement for a drawing is withdrawn.

Response to Rejections

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by and claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being obvious over Tveter (U.S. Pat. 3,865,718). Applicants respectfully traverse. However, in order to advance prosecution, claim 1 is amended to incorporate the elements of claim 2. Tveter does not disclose or suggest a testing method wherein the first testing step is a semiautogenous testing step for calculating the required grinding energy. Applicants respectfully request withdrawal of the rejection.

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Claims 1-6 are rejected under 35 U.S.C. 103(a) as being obvious over Applicant's Statement in view of Pennington (U.S. Pat. 3,791,218). Applicants respectfully traverse.

The Examiner states that the testing described by Applicant's specification employs "grinding, which is carried out over a period of time that is not immediate, necessarily suggestive of grinding carried out over a first initial period or time and second final period of time, both periods of which are sequential" (Office Action, page 3, lines 1-3). The Examiner's categorization of a single test actually being composed of a first initial period and a second final period is arbitrary and unsupportable by the literature. The Examiner has provided no support in the literature for arbitrarily categorizing a single testing step as two "periods" for testing.

As amended, claim 1 requires two sequential testing steps wherein the second testing step is performed on ore from the first step. Applicant's specification at pages 1-2 is not "necessarily suggestive of grinding carried out over a first initial period or time and second final period of time" as stated by the Examiner. On the contrary, the specification clearly indicates that the samples for the various tests "are prepared separately from the Bond ball mill test" (specification, page 2, line 4), which suggests that the various tests are not performed on the test samples from a first test. Therefore, Applicant's specification does not teach or suggest that the prior art required two sequential testing steps wherein the second testing step is performed on ore from the first step.

Applicants repeat their traversal from their previous response regarding improper hindsight reconstruction. The use of Applicant's specification combined with Pennington to render the claims 1-6 obvious is improper hindsight reconstruction. To the extent that Applicant's specification teaches or suggests the elements of claim 1, including two sequential testing steps wherein the second testing step is performed on ore from the first

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step, such teachings are part of the invention which is claimed. The Applicant's specification is required to teach the invention, and it is improper for the Examiner to categorize the Applicant's own invention as prior art and to use such teachings in hindsight reconstruction against the Applicant's claims. Applicants respectfully request withdrawal of the rejection.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. **4819-4701**. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. **4819-4701**. A DUPLICATE OF THIS SHEET IS ATTACHED.

Respectfully submitted,
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Dated: June 6, 2006

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